

**BANNER & WITCOFF, LTD.**  
INTELLECTUAL PROPERTY LAW**RECEIVED**  
**CENTRAL FAX CENTER****MAY 18 2006**601 S.W. SECOND AVENUE  
SUITE 1900  
PORTLAND, OREGON 97204TEL: 503.425.6800  
FAX: 503.425.6801  
www.bannerwitcoff.com**FACSIMILE TRANSMITTAL SHEET****To:**  
Examiner Phan; A/U # 2859**FROM:**  
Thomas L. Evans**COMPANY:**  
United States Patent & Trademark Office**DATE:**  
May 18, 2006**FAX NUMBER:**  
(571) 273-8300**TOTAL NO. OF PAGES (INCLUDING COVER SHEET):**  
11**YOUR REFERENCE No.:**  
Application No.: 10/086,644**OUR REFERENCE (C/M) No.:**  
Atty. Docket No.: 005127.00197**RE:**  
Amended Appeal Brief*If you do not receive all page(s) or have any problems receiving this transmission, please call:***NAME:** Thomas L. Evans Reg. # 35,805 **PHONE:** (503) 425-6800**COMMENTS:**

**IMPORTANT/CONFIDENTIAL:** This message is intended only for the use of the individual or entity to whom it is addressed. This message contains information from the law firm of BANNER & WITCOFF, LTD. which may be privileged, confidential or exempt from disclosure under applicable law. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution, retention, archiving, or copying of the communication is strictly prohibited. If you have received this communication in error, please notify us immediately at our telephone number listed above. We will be happy to arrange for the return of this message to our offices at no cost to you.

CHICAGO

WASHINGTON, D.C.

BOSTON

PORTLAND, OR

MAY 18 2006 PTO/SB/21 (05-03)

Approved for use through 04/30/2003. OMB 0851-0031


U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.


<b>TRANSMITTAL FORM</b>  <i>(to be used for all correspondence after initial filing)</i>	Application Number	10/086,644	
	Filing Date	February 28, 2002	
	First Named Inventor	Allan M. Schrock, et al.	
	Art Unit	2859	
	Examiner Name	Thanh S. Phan	
Total Number of Pages in This Submission	11	Attorney Docket Number	005127.00197

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form  <input type="checkbox"/> Fee Attached  <input type="checkbox"/> Amendment / Response  <input type="checkbox"/> After Final  <input type="checkbox"/> Affidavits/declaration(s)  <input type="checkbox"/> Extension of Time Request  <input type="checkbox"/> Express Abandonment Request  <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s)  <input type="checkbox"/> Response to Missing Parts/ Incomplete Application  <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.63	<input type="checkbox"/> Assignment Papers (for an Application)  <input type="checkbox"/> Drawing(s)  <input type="checkbox"/> Licensing-related Papers  <input type="checkbox"/> Petition  <input type="checkbox"/> Petition to Convert to a Provisional Application  <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address  <input type="checkbox"/> Terminal Disclaimer  <input type="checkbox"/> Request for Refund  <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information  <input type="checkbox"/> Status Letter  <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <p style="text-align: center;">- Fax Cover Sheet</p>
Remarks  Please charge any fees that are necessary to maintain to the pendency of this application, including any fees under 37 CFR §1.16 or §1.17, to deposit account number 18-0733.		

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Thomas L. Evans, Reg. No. 35, 805		
Signature			
Date	May 18, 2006		

## CERTIFICATE OF MAILING/TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Typed or printed name	Thomas L. Evans		
Signature		Date	May 18, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent

RECEIVED  
CENTRAL FAX CENTER

MAY 18 2006

In re Application for:

Allan M. SCHROCK et al.

Application No.: 10/086,644

Filed: February 28, 2002

For: PACE CALCULATION WATCH

Examiner: Thanh S. Phan  
Art Group: 2859

Attorney Docket No.: 005127.00197

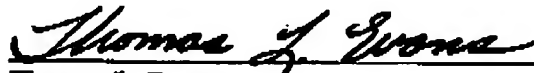
MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450AMENDED APPEAL BRIEF

Sir:

In response to the Order Returning Undocketed Appeal To Examiner mailed on May 2, 2006, Applicants respectfully submit this Amended Appeal Brief for the above identified application.

Respectfully submitted,

BANNER &amp; WITCOFF, LTD.

Date: May 18, 20061001 G Street N.W., 11<sup>th</sup> Floor  
Washington, D.C. 20001-4597  
(503) 425-6800Thomas L. Evans  
Registration No. 35,805

RECEIVED  
CENTRAL FAX CENTER

MAY 18 2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES***In re* Application of )

Allan M. SCHROCK ET AL. )

Serial Number 10/086,644 )

Filed: February 28, 2002 )

For: PACE CALCULATION WATCH )

Group Art Unit: 2859

Examiner: Thanh S. Phan

Attorney Reference: 005127.00197

**REPLY BRIEF**Commissioner for Patents  
U.S. Patent and Trademark Office  
Alexandria, VA 22313

Sir:

In response to the Examiner's Answer, mailed June 30, 2005, Appellants respectfully submit this Reply Brief in the above-captioned appeal to the Board of Patent Appeals and Interferences.

***Grounds Of Rejection To Be Reviewed On Appeal***

The following grounds of rejection have been presented to the Board of Patent Appeals and Interferences for review in this appeal:

- (a) Claims 1-8, 10-14, 16-29, 31-43 and 45-51 have been rejected under 35 U.S.C. §103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki.

(b) Claims 9, 15, 30 and 44 have been rejected under 35 U.S.C. §103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki, in further view of U.S. Patent No. 5,771,399 to Fishman

### *Arguments*

The Primary Examiner maintained the rejection of claims 1-8, 10-14, 16-29, 31-43 and 45-51 under 35 U.S.C. §103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki. Appellants again respectfully traverse this rejection, and courteously ask for its withdrawal.

Each of claims 1-51 recites the determination of a pace by dividing a distance stored in memory by an elapsed time or a segment of an elapsed time. As described in the specification, the elapsed time is a time period that has already occurred. It is not a predicted or future time period. Thus, as explained in detail in the Appeal Brief, no combination of the Thinesen and Kanzaki patents would teach or suggest the specific devices and methods for determining a pace recited in the rejected claims.

Appellants respectfully submit that the Primary Examiner's reliance on the Thinesen and Kanzaki patents is based upon a misunderstanding of their disclosures. For example, in the Examiner's Answer, the Primary Examiner stated:

Kanzaki teaches determining a pace by initiating a stop watch, timing the duration of time that it takes for a runner to run a distance X and setting the pace therefrom, see Kanzaki column 6, line 53 - column 7, line 8. (See Examiner's Answer, page 7, lines 15-17.)

To demonstrate how the Primary Examiner has misinterpreted the Kanzaki and Thinesen patents, this portion of the Kanzaki patent is reproduced in its entirety below:

In the test run mode, a pace in the first mode test run is set and a test run time in which the runner runs any distance  $x$  at the pace is measured (step A3).

The runner keys in pace data by the fourth key switch S4 to set the pace. As shown in the first test run picture B of FIG. 3, *the pace is set, for example, at 190 steps/minute*. The pace data P1 is stored in the first pace P1 memory area 5e of the RAM 5 of FIG. 2. The CPU 3 outputs a pace signal to the amplifier 6 on the basis of the pace data and the speaker 7 generates a signal sound at periods of 190 steps/minute.

As shown in FIG. 5, the runner runs a course X having any distance  $x$  at a *pace corresponding to the signal sound*. At the start of the course X, the runner depresses the fifth key switch S5 to start the stopwatch function and starts to run the course to the signal sound. The runner then stops the stopwatch function by depression of the fifth key switch S5 again at the end point of the course X to measure the test run time for the course X. The test run time data obtained in this measurement is stored in the first test run time T1 area 5f of the RAM 5. Assume now that the first run time taken is 21 seconds. (See Kanzaki, column 6, line 53 - column 7, line 8, *emphasis added*.)

If they show nothing else, the emphasized language clearly establishes that this portion of the Kanzaki patent does not teach or suggest determining a pace, as argued by the Primary Examiner.

Instead, this portion of the Kanzaki patent specifically describes having the user enter a predetermined pace. A CPU then outputs a signal corresponding to the *pace input by the user*. Thus, if the user inputs a pace of 2 mph, this is the pace information stored in the Kanzaki system, regardless of the actual pace, faster or slower, subsequently run by the user. While the Kanzaki patent does teach calculating a pace, it does not do so in the text relied upon by the Primary Examiner. Moreover, Kanzaki's methods of calculating a pace still would not teach or suggest the method and devices recited in the rejected claims, as discussed in detail by Appellants' Appeal Brief from page 3, line 27 to page 4, line 5.

The Primary Examiner's misunderstanding of the Kanzaki and Thinesen patents is further revealed by the alleged "motivation" provided to support the combination of their teachings. As

previously noted in Appellants' Appeal Brief, the Kanzaki patent is directed to a technique for discovering the pace at which a runner ideally should run. The Thinesen patent, on the other hand, is directed to a device for synchronizing a pace produced by the device with the user's actual pace. Thus, not only would the Primary Examiner's combination of the Thinesen and Kanzaki patents fail to teach the features of the invention, it would vitiate the very teachings of the Thinesen patent.

Notably, the Primary Examiner did not reply to this apparent discrepancy with a more thorough explanation of the motivation upon which the combination was predicated. The Primary Examiner instead addressed the question of motivation as follows:

In this case, a skilled artisan would have been motivated to combine the pace determine technique of Kanzaki with the pace synchronization device of Thinesen in order to obtained pace calculation necessary *to display or set* a pace. (See Examiner's Answer, page 8, lines 13-16, *emphasis added*.)

This motivation is not supported, however, by the teachings of the Kanzaki and Thinesen patents. Moreover, the Primary Examiner has not explained why the Kanzaki and Thinesen patents would be combined to provide a device that either displays or sets a pace, as each of the Kanzaki and Thinesen devices appear to provide both of these features. See, e.g., the Kanzaki patent, column 5, lines 30-32 ("...a display driver 8 and a display 9 which cooperate to display the time, pace...") and column 6, lines 56-56 ("[t]he runner keys in pace data...to set the pace..."). See, e.g., the Thinesen patent, column 2, lines 11-14 ("...one object of the present inventions [sic] is to allow...the operator to synchronize the pace which is set in a multimode alarm timepiece...") and column 8, lines 34-35 ("...and the display is updated to show the new pace..."). Appellants can therefore only conclude that the asserted combination of the Thinesen and Kanzaki patents is based upon a fundamental misinterpretation of the disclosures in these patents.

Accordingly, Appellants again submit that one of ordinary skill in the art would not have been led to combine the Thinesen and Kanzaki patents in the manner proposed by the Primary Examiner, and, further, that no combination of the Thinesen and Kanzaki patents would teach or suggested the invention as recited in any of claims 1-51. Appellants therefore again request that the rejection of claims 1-8, 10-14, 16-29, 31-43 and 45-51 under 35 U.S.C. §103 over U.S. Patent No. 5,050,141 to Thinesen in view of U.S. Patent No. 5,526,290 to Kanzaki be reversed.

The Primary Examiner also rejected claims 9, 15, 30 and 44 over the combination of the Thinesen and Kanzaki patents, in further view of U.S. Patent No. 5,771,399 to Fishman. As explained in detail above one of ordinary skill in the art would not have been led to combine the Thinesen and Kanzaki patents in the manner suggested by the Primary Examiner. Further, no combination of the Thinesen and Kanzaki patents would teach or suggest the invention as recited in any of claims 1-51. It is respectfully submitted that the Fishman patent does not remedy the omissions of the Thinesen and Kanzaki patents. Appellants therefore ask that the rejection of claims 1-51 be reversed as well.

### ***Conclusion***

In view of the foregoing arguments and those presented in Appellants' earlier Appeal Brief, Appellants again respectfully ask that the rejections submitted in the final Office Action of August 13, 2004 be reversed for at least the reasons recited above. Allowance of claims 1-51 is, therefore, respectfully requested.


A Request For Oral Hearing is being concurrently submitted with this Reply Brief. The Commissioner is authorized to charge the fees associated with that Request, together with any



other fees that may be necessary to maintain the pendency of either this application or the related appeal, to Deposit Account No. 19-0733.

Favorable action is courteously requested at the Board's earliest convenience.

Respectfully submitted,

By:   
Thomas L. Evans  
Registration No. 35,805

Banner & Witcoff, Ltd.  
1001 G Street, N.W.  
Washington, D.C. 20001-4597  
Telephone: (202) 824-3000

Dated: May 18, 2006

**Evidence Appendix**

n/a

**Related Proceedings Appendix**

n/a